

REMARKS/ARGUMENTS

The Applicants have carefully considered this application in connection with the Examiner's Action and respectfully request reconsideration of this application in view of the foregoing amendment and the following remarks.

The Applicants originally submitted Claims 1-21 in the application. The Applicants previously canceled Claims 15-21 without prejudice or disclaimer and added new Claims 22-27. The Applicants presently cancel Claims 1-14 without prejudice or disclaimer. Accordingly, Claims 22-27 are currently pending in the application.

I. Rejection of Claims 1-14 under 35 U.S.C. §102

The Examiner has rejected Claims 1-14 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,817,136 to Rhoads. However, the Applicants presently cancel Claims 1-14 without prejudice or disclaimer, rendering the Examiner's rejection moot.

II. Rejection of Claims 22-25 and 27 under 35 U.S.C. §103(a)

The Examiner has rejected Claims 22-25 and 27 under 35 U.S.C. §103(a) as being unpatentable over Rhoads in view of U.S. Patent No. 5,393,964 to Hamilton, *et al.* ("Hamilton"). The Examiner has also conceded that Rhoads fails to teach or suggest a session initiator that determines whether to use a telephone number to initiate faxing or phoning, as recited in Claim 22. (Examiner's Action, page 3). However, Hamilton also fails to teach or suggest a session initiator that extracts a telephone number from information read by a scanner and determines

whether to use the telephone number to initiate faxing or phoning, as recited in Claim 22 of the present application.

Instead of extracting a telephone number and determining whether to use the telephone number to initiate faxing or phoning, Hamilton merely scans magnetic data disposed on a card to perform a validity check. (Column 7, lines 49-54). If the card is not valid, a computer 20 displays a card rejection screen and waits for insertion of another card. (Column 7, lines 54-56). If the card is valid, a welcoming message is displayed, a telephone 36 is connected via a switching network 44 to a public communications channel 50, and a main menu of service selections is displayed. (Column 7, lines 57-60). Thus, those skilled in the art will recognize that Hamilton merely teaches scanning a card to extract financial information or access permission, as opposed to a telephone number.

Moreover, the card reader is used solely to grant user access and display the main service menu, as opposed to determining whether to use information extracted from the card for phoning or faxing, as recited in Claim 22 of the present application. For example, a user may touch a "TOUCH TO CALL" icon that causes the computer 20 to automatically dial a reservation number of a selected airline. (Column 8, lines 34-60). However, Hamilton does not disclose that the reservation number was transmitted from information scanned by the card reader 26. Accordingly, one skilled in the art can only assume that the reservation number was stored in the computer 20 before the user's card was ever scanned.

Similarly, Hamilton teaches that faxing requires the user to input a recipient's fax machine number. (Column 10, lines 31-34). More specifically, Hamilton teaches that selecting the "TOUCH FOR SENDING INFORMATION" icon causes "the transmission of papers placed into

the input tray of the fax machine 42 to the entered telephone number," thereby demonstrating that a user must input a destination number, as opposed to an automatic extraction of the number extracted from information read from a card by the card reader 26.

Thus, Hamilton fails to teach or suggest extracting a telephone number from information read by a scanner and determining whether to use the telephone number to initiate faxing or phoning, as recited in Claim 22 of the present application. Therefore, because the Examiner concedes that Rhoads also fails to teach or suggest a session initiator that determines whether to use a telephone number to initiate faxing or phoning, the combination of Rhoads and Hamilton fails to teach or suggest each and every element recited in Claim 22. Accordingly, the combination fails to support a *prima facie* case of obviousness of Claim 22 and its dependent claims. Consequently, Claims 22-25 and 27 are not obvious in view of the combination of Rhoads and Hamilton. Therefore, the Applicants request the Examiner withdraw the §103 rejection with respect to Claims 22-25 and 27.

III. Rejection of Claim 26 under 35 U.S.C. §103(a)

The Examiner has rejected Claim 26 under 35 U.S.C. §103(a) as being unpatentable over Rhoads in view Hamilton, and further in view of U.S. Patent No. 4,868,849 to Tamaoki. However, as discussed above, the combination of Rhoads and Hamilton fails to teach or suggest extracting a telephone number from information read by a scanner and determining whether to use the telephone number to initiate faxing or phoning, as recited in Claim 22 of the present application. Moreover, Tamaoki adds nothing the combination of Rhoads and Hamilton, because

Tamaoki also fails to teach or suggest extracting a telephone number from information read by a scanner and determining whether to use the telephone number to initiate faxing or phoning.

In contrast, Tamaoki merely teaches automatically initiating a telephone call per information encoded on a calling card or, alternatively, automatically determining whether to (1) dial a telephone number contained in the calling card information or (2) transmit customer information from the calling card to a number keyed in by the user. (Column 3, lines 44-54; column 4, lines 15-45). Moreover, Tamaoki fails to suggest or even mention that information encoded on the calling card may be used in determining to initiate faxing or phoning, as recited in Claim 22 of the present application.

The Examiner also asserts that it would have been obvious to one skilled in the art to incorporate into the system of Rhoads as modified by Hamilton a method of differing automatic features resulting from swiping the card in opposite directions. (Examiner's Action, page 5). However, in making such an assertion, the Examiner improperly relies on the combination of Rhoads and Hamilton. That is, the combination of Rhoads and Hamilton fails to teach or suggest extracting a telephone number from information read by a scanner and determining whether to use the telephone number to initiate faxing or phoning, as discussed above. Therefore, whether or not it would be obvious to one skilled in the art to incorporate Tamaoki's bi-directional scanning into the combination of Rhoads and Hamilton is irrelevant, because the resulting combination would still fail to teach or suggest extracting a telephone number from information read by a scanner and determining whether to use the telephone number to initiate faxing or phoning, as recited in Claim 22 of the present application.

Thus, the combination of Rhoads, Hamilton and Tamaoki fails to teach or suggest each and every element recited in Claim 22. Consequently, the combination fails to support a *prima facie* case of obviousness of Claim 22 and its dependent claims. Therefore, Claim 26 is not obvious in view of the combination of Rhoads, Hamilton and Tamaoki. Accordingly, the Applicants request the Examiner withdraw the §103 rejection with respect to Claim 26.

IV. Additional References Made of Record

The Applicants believe that the additional references made of record and not relied upon by the Examiner are not as pertinent to the claimed invention as those relied on, but the Applicants retain the right to address these references in detail, if necessary, in the future.

V. Conclusion

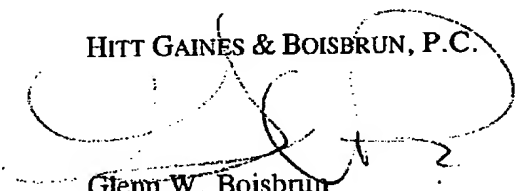
In view of the foregoing remarks, the Applicants now see all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicit a Notice of Allowance for Claims 22-27.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

The Applicants request the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please cancel Claims 1-14 without prejudice or disclaimer.